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In the Supreme Court

OF THE

United States

OCTOBER TERM, 1979

No. 79-1088

CINEMA ADULT THEATER, KENNETH ANDREW BORA, et al.,
Petitioner,

vs.

MITCHELL BROTHERS FILM GROUP, et al.,
Respondent.

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI to the United States Court of Appeals for the Fifth Circuit

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THE OPINION BELOW

The opinion of the Court of Appeals for the Fifth Circuit, filed October 16, 1979, is reported at 604 F.2d 852, 203 U.S.P.Q. 1041. The opinion of the district court is reported at 192 U.S.P.Q. 138.

STATEMENT OF THE CASE

This is a copyright infringement suit, arising under the now-superseded Copyright Act of 1909. Respondents Mitchell Brothers Film Group, et al., plaintiffs below, own a

properly registered copyright in a motion picture entitled "Behind the Green Door". Petitioner, Cinema Adult Theater, Kenneth Andrew Bora, et al., consisting of a movie theater and several individuals, obtained copies of the motion picture without plaintiffs' permission and infringed the copyright by exhibiting the film at their theater. The infringer asserted as an affirmative defense that the copyrighted movie was obscene, and that therefore plaintiffs were barred from relief. After a bench trial the district court found in defendants' favor and denied relief to the copyright owners. The Court of Appeals reversed, holding that the district court erred in permitting the assertion of obscenity as an affirmative defense to the claim of infringement, citing the controlling statutory language "all the writings of an author" [17 U.S.C. § 4 (1970) (repealed)] as facially all-inclusive, within itself admitting of no exceptions. The Court also held that the protection of all writings without regard to their content is a constitutionally permissible means of promoting science and the useful arts, and that the unclean hands doctrine was not applicable.

ARGUMENT

The decision of the Court of Appeals is the only sound legal and practical result possible and must be permitted to stand. Petitioner misrepresents the law and misreads the opinion itself in an effort to acquire from this Court what can only be characterized as license to pirate.

1. There Is No Time-Honored Obscenity Defense to a Copyright Infringement Claim.

Petitioner states in its first point that "the time-honored obscenity defense" to a copyright infringement claim is

abolished in the Fifth Circuit, and that in "all circuits other than the Fifth, the obscenity defense continues to be available." (Petition, pages 6, 7). The illusion that a so-called "obscenity defense" has ever been firmly established anywhere, let alone in all circuits, will quickly be dispelled by perusing the list of citations in its favor at page 5, note 5 of the Petition.[1] Authority for the proposition advanced by Petitioner can be described at best as ancient and scant. Indeed even Rogers, cited therein, views *Martinetti v. Maguire*, also cited therein and cited by most authorities as the source of the proposition that obscenity is not copyrightable,[2] as in fact "probably no more than a reflection of contemporary public opinion".[3] That list of authority along with the other cases and commentators considered by the Fifth Circuit are apparently exhaustive on the issue, and Petitioner advances no additional authority in its brief. If there is "conflict and confusion" surrounding the issue of copyrightability of obscenity, as Petitioner asserts, it is now resolved by the decision of the Fifth Circuit, certainly not generated by it.

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[1] Citing, from 604 F.2d 859, n.16, *Barnes v. Miner*, 122 F. 480, 489-90 (C.C.S.D.N.Y. 1903); *Martinetti v. Maguire*, 16 Fed.Cas. p. 920 (No. 9173) (C.C.Cal. 1867); *Bullard v. Esper*, 72 F.Supp. 548 (N.D.Tex. 1947); *Dane v. M.&H. Co.*, 136 USPQ 426, 429 (N.Y. Sup.Ct. 1963); *Argos Films, S.A. v. Barry International Properties, Inc.*, 77 Civ. 1062 (S.D.N.Y., July 7, 1977); 1 M. Nimmer, *On Copyright* § 1.03[B] (1978); Rogers, *Copyright and Morals*, 18 Mich.L.Rev. 390 (1920); Note, *Obscenity and Copyright*, 6 S. DakotaL.Rev. at 111-12 (1961); Comment, *Copyright Protection of Obscene Material Against Censorship as Correlated with Copyright Protection of Obscene Material Against Infringement*, 31 S. Cal.L.Rev. 301, 306 (1958) and 6 St. Mary's L.J. 274, 278 (1974).

[2] Schneider, *Authority of the Register of Copyrights to Deny Registration of a Claim to Copyright on the Ground of Obscenity*, 51 Chi-Kent L.Rev. 691, 698 (1975).

[3] Rogers, *Copyright and Morals*, 18 Mich.L.Rev. 390, 398 (1920)

2. The Fifth Circuit Decision is in Conformity with Article I, § 8, cl. 8 of the Constitution.

Where closer analysis reveals those few prior decisions to involve other issues or mere dicta,[4] the Fifth Circuit has been the first Court to confront and analyze the issue directly. Its decision is not only not in conflict with any decision of comparable authority, it is in harmony with analogous decisions by other circuits and this Court deciding the pivotal issue of whether copyright protection is to be confined to works of demonstrated "usefulness" pursuant to the U.S. Constitution, Art. I, § 8, cl., 8.[5] Faced with a statute that confers copyrightability on "all the writings of an author" [17 U.S.C. § 4 (1970) (repealed)], this proposed constitutional limitation to "usefulness" is of course the only hook on which the "obscenity defense" might hang. General acceptance of this fact is embodied in the first of Petitioner's Questions Presented.

Petitioner devotes its second and third points under Reasons to this question, with particular attention concentrated on its own inability to reconcile the Fifth Circuit decision with *Graham v. John Deere Co.*, 383 U.S. 1 (1966),

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[4]See Schneider, supra note 2, at 694-701, where that commentator extensively reviews the following cases:

Martinetti v. Maguire, 16 F.Cas. 920 (No. 9173) (C.C.Cal. 1867), *Barnes v. Miner*, 122 F.480 (C.C.S.D.N.Y. 1903); *Bullard v. Esper*, 72 F.Supp. 548 (N.D.Tex. 1947); *Khan v. Leo Feist, Inc.*, 70 F.Supp. 450, 73 USPQ 104 (S.D.N.Y. 1947); *Broder v. Zeno Mauvis Music Co.*, 88 F. 74 (C.C.N.D. Cal. 1898); *Simonton v. Gordon*, 12 F.2d 116 (S.D.N.Y. 1925); *Cain v. Universal Pictures Co., Inc.*, 47 F.Supp. 1013, 56 USPQ 8 (S.D. Cal. 1942).

[5]604 F.2d 852, at 855-856, 860, citing *Bleistein v. Donaldson Lithograph Co.* (1903) 188 U.S. 239; and *Belcher v. Tarbox* (CA 9, 1973) 486 F.2d 1087, and *Graham v. John Deere Co.* (1966) 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed. 2d 545.

which Petitioner represents as being in direct conflict. Any conflict is imagined. The *Graham* Court plainly held that although Congress' power under the Copyright and Patent Clause is limited to promoting the useful arts, it is up to Congress to decide upon the appropriate means:

> "Within the limits of the constitutional grant, the Congress may, of course, implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim."

Id. at 6, 148 U.S.P.Q. at 462. The underlying rationale may be illuminated as follows:

> "The words of the copyright clause of the constitution do not require that *writings* shall promote science or useful arts: they require that *Congress* shall promote those ends."[6]

The Fifth Circuit therefore concluded, in conformity with *Graham*, that

> "It is obvious that although Congress could require that each copyrighted work be shown to promote the useful arts (as it has with patents), it need not do so. . . . The all-inclusive nature of the 1909 Act reflects the policy judgment that encouraging the production of wheat also requires the protection of a good deal of chaff. We cannot say this judgment was so unreasonable as to exceed congressional power. We conclude that the protection of all writings, without regard to their content, is a constitutionally permissible means of promoting science and the useful arts."

604 F.2d 852, 860.

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[6]Phillips, *Copyright in Obscene Works: Some British and American Problems*, 6 Anglo-Am.L.Rev. 138, 166 (1977).

The Patent Act expressly sets forth such conditions of patentability of inventions as novelty, utility, and non-obviousness [35 U.S.C. §§ 101, 102, 103]. The Copyright Act does not impose similar conditions on writings, conferring its protection on "all the writings of an author" (or as presently superseded by the 1976 Act, on "original works of authorship." 17 U.S.C. § 102). The difference in policy reflects a recognition of the difference between Patent and Copyright, and the necessity for dissimilar treatment of the two in order to comply with the constitutional mandate to "promote . . . the useful arts." Petitioner's inability to draw any distinction whatsoever between Patent and Copyright leads it in point three to misconstrue *Graham* as limiting rather than sanctioning Congressional power to legislate as it chooses with respect to patents, to demand that that same treatment of patents be applied to copyrights, and to go so far as to paraphrase the Fifth Circuit decision by substituting the word "patent" for "copyright". (Petition, pages 11-12). The illustration is meaningless. Petitioner fails to appreciate the difference between the two concepts.

With respect to patents, it has been observed that:

> "The patent system is one in which uniform federal standards are carefully used to promote invention while at the same time preserving free competition."

Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 230, 84 S.Ct. 784, (1964). In other words, Congress must balance the need to encourage invention by guaranteeing commercial control, against the need to insure competition and free access to whatever remains in the public domain, in order to promote the maximum circulation of inventions;

that is, in order to promote the sciences and useful arts. Therefore, below a certain standard of novelty, utility and nonobviousness, inventions are not protected by patent in order to insure their availability in the public domain. It can be plainly seen that if every common item were protected by patent, the progress of science and the useful arts would be impeded rather than promoted due to the resulting lack of free competition between similar common items.

The same rationale does not apply to writings. Indisputable copyright protection alone is the inducement to creativity necessary to promote science and the useful arts through the medium of personal expression. Standards of novelty, utility and nonobviousness, or otherwise, applied to the expression of ideas in order to qualify for copyright protection and thus control of circulation, would tend to inhibit rather than promote creativity, and Congress has so determined by expressly declining to impose such controls on copyrightability. The Fifth Circuit recognized the wisdom of this Congressional policy judgment:

> "The purpose underlying the constitutional grant of power to Congress to protect writings is the promotion of original writings, an invitation to creativity. This is an expansive purpose with no stated limitations of taste or governmental acceptability."

604 F. 2d at 856. Indeed, to impose limitations would run counter to the constitutional mandate to promote the useful arts:

> "Creating a defense of obscenity—in the name of unclean hands or through any other vehicle—adds a defense not authorized by Congress that may . . . actually

frustrate the congressional purpose underlying an all-inclusive copyright statute. It will discourage creativity by freighting it with a requirement of judicial approval."

604 F.2d at 861.

3. Only Infringers Who Disseminate Materials They Believe to be Obscene Can Benefit from Any Defense to Copyright Infringement.

Petitioner facilely asserts that "authoritative definition of this constitutional copyrightability standard . . . is long overdue and necessary to the informed administration of the copyright system", (Petition, page 10) without pointing to any reasons for the necessity or the urgency. The scarcity of authority on the subject indicates that the area has not been a critical point of litigation. Indeed, it must be appreciated that by so urgently requesting this Court to define a "constitutional standard for 'creativity' necessary to justify a private copyright monopoly", (Petition, page 10) Petitioner places itself in a rather ironic position before this Court: it argues that obscenity is constitutionally "useless" and unworthy of commercial protection through copyright, in order that it may itself with impunity make its own use of the same material for its own commercial exploitation.

The situation raises a critical policy consideration that this Court must address: What possible benefit and what possible harm can inure to whom if Petitioner acquires the determination that it seeks? It seems quite clear that the only beneficiary of a policy excluding certain works from copyright protection would be Petitioner and others similarly situated, that is, all copyright pirates wanting to distribute that material themselves. And this at the cost of disrupting the entire premise and procedure of the Copyright Act.

The only other benefit possibly resulting from such a policy that has been advanced, although of course not by Petitioner, is that it might aid the control of obscenity. The Fifth Circuit addressed this point at 604 F.2d 862-863 and concluded that the theory is doubtful, and in any event, obscenity is subject to various other controls. Its conclusion is also supported by practical considerations. Since this Court held in *Miller v. California* 413 U.S. 15, 93 S.Ct. 2607, 37 L.Ed.2d 419 (1973), that what is obscene and what is not may vary from one community to another, to the point that controls on obscenity might be dropped by any state altogether, *Paris Adult Theatre I v. Slaton,* 413 U.S. 49, 64, 93 S.Ct. 2628, 2639, 37 L.Ed.2d 446, 461 (1973), it is obvious that a copyright owner identified by name with its product has a legal interest in distributing its film only to properly receptive communities, while a pirate of that film does not. The pirate merely has an interest in the widest distribution possible, without legal responsibility, since his name is not identified with the production. The lifting of copyright protection from arguably obscene matter would appear to promote rather than check the random distribution of obscenity.

The potential for harm from the policy promoted by Petitioner is extensive. Besides the possibly insurmountable confusion engendered by the required application of the local-community-standard doctrine of *Miller v. California, supra,* and *Paris Adult Theatre, supra,* in a federal

context,[7] and the unmanageable array of philosophical and aesthetic considerations that would necessarily be injected into routine infringement actions,[8] such a policy ultimately must constitute the tip of an iceberg of commercial disruption. The great danger of the whole concept of an "obscenity defense" to copyright infringement is that as a constitutional construct it is agreed that it must rest solely on a standard of "usefulness", pursuant to Article I § 8 cl.8. Thus sexual expression is only one category vulnerable to attack.[9] The parade of popular music, dance, sport, books, films, and television shows challenged for demonstrable "usefulness" could be endless, as copyright pirates expand and assert their "defenses". Clearly, the commercial vitality of the expressive arts and the media has always depended on a complete and unassailable property right guaranteed through copyright, and Congress purposely drafted an all-inclusive Copyright Act in full recognition of that fact. The decision of the Fifth Circuit is a thorough analysis and reaffirmation of legal and economic concepts of long standing, and no sensible reason compels its disturbance at this time.

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[7]See 604 F.2d at 858; and note should also be taken that the problem of applying *Miller* in a federal context was recognized by Petitioner in its Question Two, but was dealt with nowhere in the Petition.

[8]See 604 F.2d at 863.

[9]*Jenkins v. Georgia*, 418 U.S. 153 (1974), where the Supreme Court reversed the Georgia Supreme Court's finding that the major motion picture "Carnal Knowledge" was obscene, stands as an indication of a difficult area of application that copyright pirates can be expected to invade if the policy they are promoting prevails.

CONCLUSION

The decision of the Fifth Circuit in *Mitchell Brothers Film Group, et al. v. Cinema Adult Theater, et al.*, 604 F.2d 852, must be permitted to stand, and therefore the Petition for Writ of Certiorari herein should be denied.

Respectively submitted,

JOSEPH RHINE